

**REMARKS*****Claim Disposition***

Claims 1 – 25 are pending in the application. Claims 8 – 17 and 23 – 25 have been withdrawn from consideration subject to a restriction and election. Applicants respectfully disagree with the Examiner's restriction and the assertions made in Detailed Action 1. Applicants are not able to respond to the rhetorical questions, nor the opinions, presented therein. Applicants maintain that no additional burden was required to properly search based on the restricted claims.

***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 1-7 and 18-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kimmlingen et al. United States Patent No. 6,418,336 (hereinafter Kimmlingen '336) in view of Katznelson et al. United States Patent No. 5,736,858 (hereinafter Katznelson '858)..

Applicants respectfully point out that the Examiner has provided a single rejection with respect to a grouping of all claims. No justification has been provided for where in the cited references each of the claimed elements are purportedly disclosed. Applicants respectfully suggest that the Office Action is incomplete for failing to provide a clear disposition of all claims. Moreover, the rejections are unclear because the claims are grouped together despite the fact that some independent claims include limitations that others do not. "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." MPEP §707.07(d). Claim 5 particularly includes limitations not in Claim 1. There is no explanation as to where each of the elements of Claim 5 are taught in the cited references, and in fact, they

are not. Applicants have provided a response and explanation to the best address the rejections in light of the ambiguity.

Regarding Claims 1 -- 7 and 18 - 22:

Applicants respectfully contend, that the explanation provided with the office action mischaracterizes the disclosures of Kimmlingen '336 and Katznelson '858, and further contends that the inclusion of such coils in a system such as Kimmlingen would not have obvious to the artisan of ordinary skill in the art at the time that the invention was made. The Examiner suggests that:

"Kimmlingen discloses a multiple portion coil system for MRI. Applicant's attention is directed to the description of Fig. 1 and claim 1 of the Kimmlingen disclosure. The multiple portion coil allows for imaging in a plurality of fields of view as most simply described in the abstract of the disclosure. Note that the multiple portion coil is a Z-gradient coil.

The only difference between Kimmlingen and the claims at issue is that Kimmlingen does not specifically show or explicitly describe the other two gradient coils, that is the X-gradient and Y-gradient coils.

The inclusion of such coils in a system such as Kimmlingen, would have been obvious to the artisan of ordinary skill in the art. It is well known that for MRI three sets of orthogonal gradients would be needed. See for example lines 25-45 of col. 1 of Katznelson."

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143

Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Finally, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing ... that the proposed modification of the prior art must have had a reasonable expectation of success. MPEP 2143.02. Moreover, the suggested modification cannot change the principle of operation of a reference. MPEP 2143.01.

Applicants respectfully contend, that the explanation provided with the office action mischaracterizes the disclosure of Kimmlingen '336 and Katznelson '858 and it provides no justification for the suggested combination of Kimmlingen '336 with Katznelson '858. In particular, neither Kimmlingen '336 nor Katznelson '858, whether alone or in combination, disclose numerous elements of the claimed invention. For example, as in Claims 3 and 5, neither Kimmlingen '336 nor Katznelson '858 disclose or teach, "wherein at least one of said first gradient coil and said second gradient coil comprise only a single gradient coil." Nor do Kimmlingen '336 and Katznelson '858 teach or disclose "an first gradient coil configured to generate a first gradient field in a single field of view." To support the explanation in the Office Action, the Examiner relies on Fig. 1 and Claim one. However, Kimmlingen '336 and Katznelson teach away from the claimed invention by each requiring "at least two imaging regions" and "at least tow independently controllable coils portions" in the coils (Claim 1). Therefore, because neither Kimmlingen '336 nor Katznelson '858 disclose or teach numerous elements of the invention they may

not be employed to render the Applicant's claims unpatentable. Thus, Claim 1 - 7 and 18 - 22 are allowable, the rejections are improper, and they should be withdrawn.

Claims 2 - 4, 6 - 7, and 19 - 21 include the same limitations as Claims 1, 5, and 18 respectively, and therefore, are also allowable and are improperly rejected. Thus, the rejections of Claims 2 - 4, 6 - 7, and 19 - 21 should be withdrawn. Moreover, Claims 2 - 4, 6 - 7, and 19 - 21 depend from Claims 1, 5, and 18 respectively, which are allowable based upon the above presented arguments, and thus Claims 2 - 4, 6 - 7, and 19 - 21 are allowable as well.

Finally, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing ... that the proposed modification of the prior art must have had a reasonable expectation of success. MPEP 2143.02. Moreover, the suggested modification cannot change the principle of operation of a reference. MPEP 2143.01. Making the suggested modification to Kimmlingen '336 would be in direct contravention to its teachings and therefore change a principle of operation taught therein. Such a modification is not permissible. Therefore, the Examiner has not made a prima facie case for obviousness. Thus, neither Kimmlingen '336 nor Katznelson '858 may be employed to render the Applicants claims unpatentable. Thus, Claims 1 - 7 and 18 - 22 are allowable, the rejections are improper, and they should be withdrawn.

The arguments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims were not amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicants are entitled has been surrendered. Allowance of the claims is respectfully requested in view of the amendments and following remarks. Moreover, no amendments as presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection. It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicants. Accordingly, reconsideration and withdrawal of the rejections are requested.

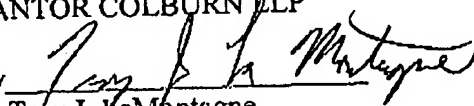
In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are additional charges with respect to this matter or otherwise, please charge them to Deposit Account No. 07-0845.

Respectfully Submitted,

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By



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